

Application No.: 10/509,144  
Attorney Docket No.: P098US  
First Applicant's Name: Kurt Berlin  
Application Filing Date: 27 September 2004  
Date of Office Action: 12 November 2009  
Date of Response: 07 May 2010  
Examiner: Steven C. Pohnert

#### **REMARKS**

Claims 1-11 are pending and stand rejected.

Attached: Affidavit under 37 CFR 1.132.

Applicant acknowledges the Examiner's rejection of claims 1-6, 8-11 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Berlin (WO01/27317, Published April 19, 2001, now U.S. Patent No. 7,179,594, hereafter "Berlin") in view of Allis (WO02/18418 published March 07 2002, hereafter "Allis"), Pradhan, et al (Journal of Biological Chemistry 1999 vol. 274, p. 33002-33010, hereafter "Pradhan") and New England BioLabs catalog (2000-2001. P. 91, hereafter "New England BioLabs catalog"). Applicant respectfully traverses these rejections based on the rebuttal arguments of record and presented herein.

Applicant acknowledges the Examiner's rejection of claim 7 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Berlin in view of Allis, Pradhan, New England BioLabs catalog and further in view of Shatkin et al (U.S. Patent 6312926, hereafter "Shatkin"). Applicant respectfully traverses these rejections based on the rebuttal arguments of record and presented herein.

Applicant acknowledges the Examiner's provisional obviousness-type double patenting rejection of claims 1-5 in view of Application No. 11/904,320 in view of Allis and Berlin. Since this is only a provisional rejection, Applicant wishes to postpone responding to the same until such time that the rejection is no longer of a provisional nature.

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### ***Priority***

The Examiner on page 2 of the office communication inadvertently states that the instant application claims priority to German Application 102 14 232.7 filed March 25, 2003. However, the instant application claims priority to German Application 102 14 232.7 filed March 25, 2002. The certified copy of the said priority application in English has been filed and received by the USPTO on September 27, 2004.

The Examiner relies on Berlin reference for the obviousness rejection under 35 U.S.C. § 103(a). Applicant traverse this rejection based on the fact that Berlin reference is not a prior art reference under 35 U.S.C. § 102 (a)-(g).

Berlin was published on April 19, 2001 as opposed to the Examiner's indication of April 01, 2001 (Page 3 of the office communication). The instant application claims priority of March 25, 2002. Since English translation of the claimed foreign priority application has been provided to the office, according to 37 CFR 1.55 and MPEP 201.15 Applicant's claim of priority is valid. Therefore, Berlin reference is not a prior art reference under 35 U.S.C. § 102(b), since it was not published more than a year from priority date of the instant application.

In order to disqualify Berlin reference as 35 U.S.C. § 102(a), Applicant, herewith, submit an affidavit under 37 CFR 1.132 in order to show that Berlin reference invention is not by "another". Dr. Kurt Berlin is the sole inventor of the instant application and Berlin reference. Therefore, Berlin reference is not a prior art under 35 U.S.C. § 102(a).

Further, Berlin reference is not 35 U.S.C. § 102(e) reference due to the fact that Berlin International Application was filed on October 13, 2000 which is before November 29, 2000. Therefore, there is no 35 U.S.C. § 102(e) date and Berlin reference could be prior art as of its publication date under 35 U.S.C. § 102(a) or 102(b). As explained above, Berlin is neither 35 U.S.C. § 102(a) nor 102(b). Berlin U.S. Patent No. 7,179,594 has 102(e) date of October 21, 2002 (when

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371(c) (1), (2), (4), requirements are completed) which is after the instant application's claimed priority date of March 25, 2002. Therefore, Berlin U.S. Patent No. 7,179,594 is not a valid reference. In any case, under 35 U.S.C. § 103(c), Berlin reference is not a prior art reference for the instant application.

Therefore, Applicant respectfully request the Examiner to withdraw the Berlin reference as cited prior art in assessing the patentability of the instant application.

### ***Rejection under 35 U.S.C. § 103***

Claims 1-6, 8-11 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Berlin, in view of Allis, Pradhan, and New England BioLabs. Applicant respectfully traverses these rejections based on the rebuttal arguments of record and presented herein.

As explained above under Priority section, Berlin reference is not a prior art reference. Accordingly, Applicant respectfully requests the Examiner to withdraw this rejection.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Berlin in view of Allis, Pradhan, New England BioLabs catalog and further in view of Shatkin. Applicant respectfully traverses these rejections based on the rebuttal arguments of record and presented herein.

This rejection is moot in view of disqualifying Berlin as a prior art reference.

### ***Double Patenting***

Claims 1-5 are rejected provisionally for obviousness-type double patenting in view of Application No. 11/904,320 in view of Allis and Berlin. Since this is only a provisional rejection,

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Applicant wishes to postpone responding to the same until such time that the rejection is no longer of a provisional nature.

### ***Conclusion***

In view of the foregoing amendments and remarks, Applicants respectfully request entry of the present Amendment and allowance of the amended claim set provided herein. The Examiner is encouraged to phone Applicants' agent, Ramin Amirsehhi, to resolve any outstanding issues and expedite allowance of this application.

If there are any fees due in connection with filing of this paper that are not accounted for, the Examiner is authorized to charge the fees to our **Deposit Account No. 50-5185**. If a fee is required for an extension of time under 37 C.F.R. 1.136 that is not accounted for already, such an extension of time is requested and the fee should also be charged to our Deposit account.

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Respectfully submitted,

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